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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,020	06/01/2005	Paolo Balliello	PL/2-22807/A/PCT	8510
324	7590	06/29/2008	EXAMINER	
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			ABU ALI, SHUANGYI	
			ART UNIT	PAPER NUMBER
			1793	
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			06/20/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,020

Applicant(s)

BALLIELLO, PAOLO

Examiner

SHUANGYI ABU ALI

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

(1)

Status of Claims

Claims 1-9 and 11-21 remain for examination wherein claims 1-2 and 7 are amended.

(2)

Claim Rejections - 35 USC § 103

The rejection of claims 1-6 and 11-18 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of GB 1176217 and U. S. Patent No. 3,728,143 to Pollard et al. , further in view of U. S. Patent No. 4,264,552 to Macmahon et al. as generally set forth in the first office action mailed 12/11/2007 stands.

The rejection of claims 7, 9 and 19-21 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Pollard et al., '217 and Macmahon et al., further in view of U. S. Patent No. 5,681,876 to Schneider et al. as generally set forth in the first office action mailed 12/11/2007 stands.

The rejection of claim 8 under 35 U.S.C. 103(a) as being unpatentable over combined teaching of Hollard et al., '217, Macmahon et al. and Schneider et al, further in view of U. S. patent No. 5,082,498 to Kurtz et al. as generally set forth in the first office action mailed 12/11/2007 stands.

The text of those sections of title 35 US Code not included in this action can be found in the prior Office Action.

(3)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over combined teaching of GB 1176217 and U. S. Patent No. 3,728,143 to Pollard et al. , further in view of U. S. Patent No. 4,264,552 to Macmahon et al.

Regarding claim 22, '217 disclose a composition comprising pigment and hydroxyalkylcellulose. '217 disclose that cellulose with different degree of substitution displays different solubility in the medium (page 2, lines 6-10). '217 disclose that the ratio of the cellulose to pigment is preferred in the range of 1:9 to 1:4 (page 2, lines 22-25). Pollard, also drawn to pigment treatment, discloses a pigment composition treated with fatty acid amide derived from fatty acid and amine (col. 4, line 55 to col. 6, line 48).

The ratio of fatty acid amide to pigment is preferred in the range of 1:9 to 9:1 (col. 8, lines 74-75).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to use fatty acid amide in '217 pigment composition, motivated by the fact that Pollard et al. disclose that the pigment treated with fatty acid amide is dustless and brilliant reflected hues, increased opacity of opaque pigments, increased transparency of transparent pigments, and increased pigment concentrations of the polymer. (col. 9, lines 37-39 and col. 3, lines 63-71).

Combined teaching of Pollard and '217 disclose that the ratio of amide to cellulose derivative is overlapped with the instant application's ratio. But they are silent that amine is used in the composition and the amount of the additive (cellulose derivative and amine) in the composition.

However, Macmahon et al. disclose additives composition is used to treat pigment. The additive composition can be cellulose derivatives, amine (col. 3, lines 35-37) and amide. The additive system is preferred in the range of 0.5% to 20% based on the weight of the pigment (col. 4, lines 5-10). It is the position of the Examiner that the interchangeability on one known surfactant for another that are both known for the same purpose is clearly within the scope of the skilled artisan.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to utilize cellulose and amine amount as applicant set forth in claim 1, motivated by the fact that Macmahon et al, also drawn to a pigment

composition, disclose that the additive system is preferred in the range of 0.5% to 20% based on the weight of the pigment for the reason of the cost (col. 4, lines 5-10).

(4)

Response to Arguments

Applicant's arguments filed 03/14/2008 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-9 and 11-21 as indicated in the previous Office Action stand.

Applicant argues that prior art GB 1, 176,217 and U. S. patent No. 3, 728, 143 can not be combined. The Examiner respectfully submits that both '217 and Pollard are drawn to surface treatment of pigment, whether by coating the pigment or mixing the pigment in a dispersion. And the pigment obtained has beneficial properties (col. 9, lines 37-39 and col. 3, lines 63-71). Furthermore Pollard is also used to show that the surface treated pigment can be used to pigment polymers.

Applicant argues that combined teaching of '217, Pollard and '552 do not provide the limitation of the instant claims. The Examiner respectfully submits that '217 discloses that the ratio of cellulose to pigment is about 1:9 to 1:4. Pollard discloses that the ratio of amide to pigment is about 1:9 to 9:1. If cellulose to pigment ratio is 1:9 and amide to pigment ratio is 1:9, then the ratio of cellulose to amide is 1:1. '522 disclose that for the sake of the cost, the additive composition (amide and cellulose) amount is preferred 0.5% to 20% based on the pigment weight. Therefore, combined teaching of '217, Pollard and '552 meet the limitation of the instant claims. Furthermore, the

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applicant does not provide any factual evidence to show the unexpected result of the disclosed concentration.

Applicant argues that '555 discloses a different kind of binder composition. The Examiner respectfully submits that first, '552 is used to show the amount of bind composition in the pigment composition. Second, '552 disclose that the binder composition comprises amide, fatty acid, amine and cellulose.

Applicant argues that the instant application provide novel means for the long sought economic goal. The Examiner respectfully submits that the economic goal is disclosed by Macmahon already, who disclose the additive composition amount in the range of 0.5-20% based on the pigment amount.

Applicant argues that '552 binder composition comprise of large amount of water. The examiner respectfully submits that the final product contains no water.

Since the rejection of 1-16 and 1-18 are valid, the ground for rejection of the rest claims stand as set froth in the previous office action

(5)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHUANGYI ABU ALI whose telephone number is (571)272-6453. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

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